

RECEIVED
CENTRAL FAX CENTER
MAR 26 2007

REMARKS

The Examiner is thanked for her courtesy in indicating that all outstanding rejections and objections were overcome by the Amendment of July 17, 2006.

In paragraph 3 of the Office Action, claims 1, 3 and 7-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP06-200273 (JP-273) in view of Naka et al. (Naka).

Reconsideration is requested.

The present invention provides a nitrite-free grease that is effective in preventing the peeling of a surface of a bearing during high stress operating conditions. Thus, the novel grease of the invention will extend the service life of a sealed bearing when that bearing is lubricated with the claimed grease of the present invention. the grease of the invention and also avoids exposing people and the environment to harmful nitrites.

New claim 14 points out an embodiment of the invention which consist essentially of the recited ingredients. This claim excludes the preferred active ingredients of the prior art that are not recited in the claim and favorable consideration is requested.

JP-273 only discloses a grease that contains ingredients other than a dibasic acid salt. Example 7 and Comparative Example 1 of the present application provide data which show the effect of the presence of a dibasic acid in a grease composition. JP-273 utilizes a polyester as a base stock and does not disclose the use of a base oil having 20% or more of an alkyl diphenyl ether oil in the base stock, an organic bentonite as a thickener and a dibasic acid as a rust preventative. Naka is limited to a disclosure of a grease composition for rolling bearings where the grease composition contains a diurea thickener but no dibasic acid.

There is no direction or teaching in either JP-273 or in Naka that would suggest that certain teachings of these references should be followed and certain teachings should be used so that the bentonite of

JP-273 would not be used but the dibasic salt of Naka would be used in the "bentonite free" grease of JP-273. Nothing directs a skilled worker in the lubricating arts to selectively combine the teachings of JP-273 and Naka in such a manner that the resulting grease would contain both a dibasic acid and an aromatic thiourea.

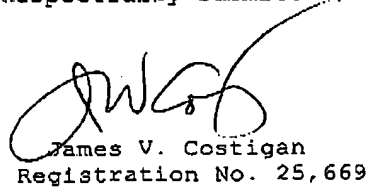
Tables 1 and 2 in the specification provide data that establish that the claimed grease composition avoids the abnormal peeling on rolling surface of a ball and roller bearing. Additional data is attached hereto in the form of an unsigned Declaration Under 37 CFR§1.132.

The attached unsigned Declaration Under 37 CFR1.132 reports comparative test data which further shows the effect on a grease composition that does not include a metal salt of a dibasic acid. The Examiner is asked to Comparative Example 8 of Table 2a in conjunction with Original Example 7, of the specification, as filed. These Examples are made with the same base oil, the same thickener and have the same viscosities but in the high temperature/high speed test, the composition according to the invention has a time to bearing failure which is almost 7 times longer than the time to failure for the comparative composition. This extended performance for the grease according to the invention is unexpected and could not have been predicted from the teachings of the prior art references.

The Examiner commented that one skilled in the art would have been motivated by the teachings of Naka to use the diurea compound in the JP-273 composition. It is submitted that this analysis of the teachings of Naka is based only on hindsight because the most that can be gleaned from Naka is that the diurea compound is of use in a grease composition. It does not suggest any specific type of grease other than the Naka grease where the diurea compound could be used and since the JP-273 patent was not mentioned by Naka, no one would be motivated to modify the JP-273 patent without a specific suggestion or teaching. In any event, the test which shows the result of adding the dibasic acid to a nitrite free grease based on a base oil, a diurea compound and a thickener rebuts any inference of obviousness. For these reasons, it is requested that this ground of rejection be withdrawn.

An early and favorable action is earnestly solicited.

Respectfully submitted,



James V. Costigan
Registration No. 25,669

Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, N.Y. 10036-2646
(212) 302-8989